

REMARKS

Applicant would first like to thank the Examiner for the phone interview conducted on April 1, 2004 regarding the above-identified application. During the phone interview Applicants discussed the rejection and the cited prior art. No final agreement was reached, however, this amendment has been filed in response along with the following arguments.

With regard to independent claims 1 and 10, these claims have been amended to more clearly define and distinguish the present invention over the cited art. Both claims 1 and 10 are directed to a method for automatically providing at least one goods and/or service by a service provider with respect to a plurality of customer provided images. Claim 1 further sets forth about the automatic providing of a goods and/or service to a recipient designated by the customer incorporating said at least one image stored on said database after reaching a predetermined criteria status with respect to said customer account prior to receipt of the images by said service provider that are required to provide the goods and/or service. These claims as amended allow for access to the images over a communication network by the customer.

The Examiner, in paragraph 1 of the official action, rejected claims 10 and 11 under 35 USC § 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the invention in that the phrase "goods and/or services" does not clearly meet the bounds of patent protection desired. In this regard, Applicant respectfully refer the Examiner to MPEP 2173.05(b) subsection 2 wherein terminology setting forth alternatives by the use of the conjunction "or" is perfectly allowable. The only issue to address is whether or not the claim is definite as to what is being set forth. Applicant respectfully submit that the alternative expression set forth in the independent claims is appropriate and clearly defines the meets and bounds of the invention. The claims clearly state that goods, services or goods and services may be provided.

The Examiner rejected claims 1, 3-6, 8, 10-13 and 15 under 35 USC § 102(b) based on PhotoNet (PTO-892, Item U) for the reasons set forth therein. Applicant respectfully submit that the PhotoNet reference referred to by the Examiner does not teach or suggest the invention as taught and claimed by Applicant. In fact, the PhotoNet system at that time taught away from the present

invention. As set forth on the 4th page of the cited reference in discussing how long the photos are kept on line, it stated that your photos are kept on line for 30 days and that you would be notified by e-mail before your rolls expired and you can extend the life of the rolls by purchasing long term storage. There is no teaching or suggestion of providing a goods or services upon reaching a predetermined criteria. Quite the opposite, it teaches away from such as it is advising the customer that the images will be automatically deleted from storage. Thus, it does not teach the automatically providing of goods or services as taught and claimed by Applicant. Further, there is no teaching or suggestion of establishing a predetermined criteria with respect to a customer account as taught and claimed by Applicant upon which the goods or services are automatically provided. Applicants respectfully submit that the PhotoNet reference does not teach or suggest the invention as taught and claimed by Applicant.

The Examiner rejected claim 2 under 35 USC § 103(a) as being unpatentable over PhotoNet in view of Florida Times Union (Paper #12) as applied to claim 1, further in view of Item Processing Report referred to as "IPR" for the reasons set forth in paragraph 3. Claim 2 is dependent upon independent claim 1 and is therefore patentably distinct for the same reasons previously discussed. The Florida Times Report, (second Item U) is nothing more than a further elaboration of the PhotoNet system of reference U and thus, for the reasons previously discussed, does not teach anything that would render independent claim 1 obvious as previously discussed with respect to claim 1. It is respectfully submitted the IPR reference is of little relevance to the present invention. In particular, this reference simply discloses an archiving system for storing cancelled checks. It is clear that the system disclosed in IPR is not accessible over a communication network as claimed by Applicants. Independent claims 1 and 10 specifically set forth providing a database by the service provider for storing digital images with respect to a customer account that is accessible by said customer over a communication network. By allowing the customer to have access to the images, the customer is able to provide modification to the images such that the goods or services to be provided, which incorporate the previously supplied customer images, will provide a more pleasing (desirable) product to the consumer. The IPR reference clearly does not teach or suggest the providing of such. Furthermore, the present invention, as set forth by claim 1, is directed to

providing goods and/or services. The present invention allows for providing multiple different types of goods or services which incorporate images sent. For example, hardcopy prints, T-shirts, in addition CDs may be provided to the customer. This is in contrast to the IPR reference which is simply scanning text and then writing the scanned information onto a CD. Furthermore, the claim specifically sets forth the sending of goods or services that incorporate the images to a recipient designated by the customer. Since what is being copied are checks, the checks are going to be returned to the person originating the checks. In the present invention, the goods or services that are to be provided may be sent to the customer or any person designated to receive such products, such as a relative or close friend. Thus, it can be seen that the IPR reference is directed to a system totally apart and distinct from the present invention and there is no motivation or suggestion to combine the references.

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation or suggestion to select and combine the references relied upon as evidence of obviousness. See *In re Lee* CAFC 277 Fed 3rd 1338 (61 USPQ 2nd 1430) 2002 at page 1434. The Court stated:

"Our case law makes it clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."

"teachings of references can be combined only if there is some suggestion or incentive to do so."

In the instant case, the IPR reference is directed to a banking system whereas the PhotoNet is directed to a sharing type situation where images are designed to be freely accessed over a communication network and shared. One would not look to the check storage archiving of the IPR system to provide the open accessible on-line photo network system of the PhotoNet system. The two are directed to two totally different type businesses and are directed to obtaining different type results. The PhotoNet system is directed to providing on-line photo center for accessing images over a remote communication network for ordering goods and/or services incorporating supplied images, whereas the IPR is simply directed to a system for storing cancelled checks on a CD. In view of the foregoing,

Applicant respectfully submits that it would not be obvious to combine the references or obtain the invention as set forth by Applicants for the reasons set forth above.

The Examiner rejected claims 7, 9 and 16 for the reasons set forth in paragraphs 4, 5 and 6. However, these are all dependent upon independent claims 1 or 10 and therefore are patentably distinct for the same reasons as previously discussed.

The Examiner, in paragraph 7, rejected claims 17-26, 30-34, 36-37, 40, 42, 44-45, 48-49, 51, 53-54, 58-60, 62-66, 69, 71 and 73-74 as being obvious under 35 USC § 103(a) over PhotoNet in view of Komiya et al. for the reasons set forth therein. In this regard Applicant would like to point out that independent claim 17 is directed for organizing images obtained from a plurality of discreet image retaining devices with respect to a customer account of a customer. Examples of image retaining devices are film cartridges having film therein.

The claim further provides that the image retaining device, each having a unique ID, in that the ID for each of said image retaining device is forwarded to the database of network photo service provider for storage prior to the network photo service provider receiving the image retaining devices for associating with the customer account for delivery of goods and/or services to a recipient designated by the customer. The Komiya et al. reference is directed to an article packing system for packing tubular articles within small boxes and placing small boxes in various combination and corrugated boxes under control of a computer and more particularly to an article packaging system for packaging cartridge with photographed films housed therein. See column 1, lines 6-12. This is not directed to a system that employs ID references for forwarding to a photo service provider such that goods or services may be provided with respect to images that have been captured on the film cartridge. Quite the contrary, this is simply directed to a packaging system which is totally apart and distinct to which the present invention is directed. Clearly, this is not relevant to the PhotoNet system described in the PhotoNet reference. Further, it would not teach or suggest anything which would render Applicants claims unpatentable. While Komiya et al. teaches IDs that are used for packaging of the product, it does not teach or suggest the forwarding of the IDs to a photo service provider as taught and claimed by Applicant. As previously discussed, there must be some

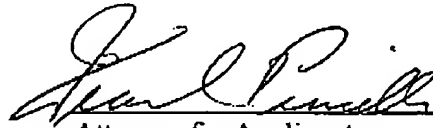
motivation, teaching, or suggestion to make the modification as suggested by the Examiner. In this regard the references are directed to two totally different aspects i.e., the PhotoNet directed to an on-line photo service provider and the other directed to a film packaging system for delivering of film to purchasers. There would be no teaching or suggestion in either of the references of pre-registering the IDs for providing goods or services prior to receipt of images as claimed. In view of the foregoing, Applicants submit that these claims are patentably distinct for the reasons previously discussed.

With regard to the rejection of claims set forth in paragraphs 8-15, these are all dependent claims and are patentably distinct for the same reasons as the independent claims upon which they depend. The newly cited references failed to teach or suggest anything which would render the independent claims obvious and therefore are patentably distinct for the same reasons previously discussed.

With regard to new independent claims 77 and 78, these are directed to a new method and system for automatically providing goods or services with respect to a plurality of customer provided images which include providing a database by a service provider for storing plurality of images in digital format with respect to a customer account and associating therewith a criteria established by the customer for providing at least one goods or service with respect to the image to be later provided which incorporates at least one image from the plurality of images stored on the database. As previously discussed, the PhotoNet reference does not teach or suggest the establishment of the predetermined criteria. As previously discussed, these claims are not limited to a particular goods or service to be provided and can be sent to any designated party, and is not restricted to returning of the goods or services to the customer that set up the account. In addition, this is also distinguishable over the IPR reference for many of the same reasons previously discussed in that the IPR is not a system designed for incorporating images in various goods and/or services. The check that is forwarded is not an image designed to be incorporated into goods or services but are just simply being archived, nor can they be sent to any designated party.

In view of the foregoing, it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Frank Pincelli', is written over a horizontal line.

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